FILE COPY

Supreme Court, U.S.
FILED
NOV 20 1959
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

October Term, 1959

No. 191

PATRO BROTHERS SLATE CO., INC., PETITIONER,

v.

MATTHEW HANNON, RESPONDENT.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

JOHN C. BLAIR
One Atlantic Street
Stamford, Connecticut
Attorney for Respondent

Of Counsel:

BLAIR SPENCER & BUCKLEY
ROBERT H. WARE
ROBERT A. CESARI
F. EUGENE DAVIS IV
One Atlantic Street
Stamford, Connecticut

J. MALCOLM WILLIAMS
Poultney, Vermont.

November 19, 1959

TABLE OF CONTENTS

	PAGE
PROCEEDINGS BELOW	1
QUESTION PRESENTED	1
BACKGROUND OF THE LITIGATION	2
PETITIONER'S REASONS FOR SEEKING CERTIORARI ARE UNFOUNDED	5
1. This case presents no question of interpretation of the Patent Act of 1952 requiring this Court's consideration, since the Tatko patent is invalid under any conceivable standard of invention	5
2. The default judgment in the District Court of Maine was not a "decision" in conflict with the decision of the Court below	7
3. The facts do not support Petitioner's contention that a conflict between the circuits is unlikely	7
4. The decision of the Court below as to "obviousness" is not in conflict with the decisions of any other circuits	8
5. The decision of the Court of Appeals that the evidence presented in the District Court failed to establish long-felt want is not in conflict with decisions of this Court	9
CONCLUSION	10

TABLE OF CASES

Blish, Mize and Silliman Hardware Co. v. *Time Saver Tools, Inc.*, 236 F. 2d 913, 111 U. S. P. Q. 6 (10th Cir. 1956), cert. denied, 352 U. S. 1004 (1957) 6

PAGE

Glitsch & Sons v. *Wyatt*, 224 F. 2d 331, 106 U. S. P. Q. 162 (5th Cir. 1955) 6

Hobbs v. *Wisconsin Power & Light Co.*, 250 F. 2d 100, 115 U. S. P. Q. 371 (7th Cir. 1957), cert. denied, 356 U. S. 932 (1958) 6

Layne & Bowler Corp. v. *Western Well Works, Inc.*, 261 U. S. 387 (1923) 7

L-O-F Glass Fibers Co. v. *Watson*, 228 F. 2d 496 (3rd Cir. 1956) 8

Lyon v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530 (2nd Cir. 1955), cert. denied, 350 U. S. 911 (1955) 8

...mal Slug Rejectors, Inc. v. *A. B. T. Mfg. Co.*, 16 F. 2d 333, 75 U. S. P. Q. 151 (7th Cir. 1947), cert. denied, 333 U. S. 832 (1948) 6

Noble v. *C. S. Johnson Co.*, 241 F. 2d 469, 112 U. S. P. Q. 350 (7th Cir. 1947) 5

Otto v. *Koppers Co.*, 246 F. 2d 789 (4th Cir. 1957) 8

Palmer v. *Ludens, Inc.*, 236 F. 2d 496 (3rd Cir. 1956) 8

Tatko Brothers Slate Co., Inc. v. *Bergen Bluestone Co., Inc.*, D. C. N. J. Newark, Doc. 490/55, settled and dismissed March 23, 1956, 706 Pat. Off. Official Gazette 5 (May 1, 1956) 7

Vermont Structural Slate Co., Inc. v. *Tatko Brothers Slate Co., Inc.*, 134 F. Supp. 4, 107 U. S. P. Q. 86 (N. D. N. Y. 1955), aff'd. 233 F. 2d 9, 109 U. S. P. Q. 306 (2nd Cir. 1956) 2, 3, 5

IN THE

Supreme Court of the United States

October Term, 1959

No. 491

TATKO BROTHERS SLATE CO., INC., PETITIONER,

v.

MATTHEW HANNON, RESPONDENT.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

Proceedings Below

Petitioner seeks a writ of certiorari to review the decision of the United States Court of Appeals for the Second Circuit, filed September 11, 1959, ___ F. 2d ___, 122 U. S. P. Q. 585, reversing the decision of the United States District Court for the District of Vermont, 157 F. Supp. 277.

Question Presented

Should this Court review an ordinary patent case in which the "unobviousness" of the asserted "invention" depends solely on "long-felt want", when the Court of Appeals concluded that "long-felt want" did not exist in view of the District Court's findings?

* * * * *

The crux of the Court of Appeals' holding relevant to this question is found in the following language, 122 U. S. P. Q. at pages 586-587:

> "For the patentee himself testified, as the court below found, that he conceived the slotted pallet in June 1951; and that he concealed his invention until January 1954; because until that time the building supply industry was insufficiently supplied with fork-lift trucks [upon which the utility of pallets largely depended] to make it desirable to palletize the industry and until then 'the demand for palletized slate * * * was very limited'. But of course when the demand for palletized slate was 'very limited', one could not expect an effort by the industry generally to develop improved pallets. * * * Thus Tatko's testimony leaves no room for a contention that his 'invention' was one to fill a long-felt want which others had long and unsuccessfully sought to fill: the want was not felt until the prevalence of the fork-lift trucks and then was promptly filled."

Background of the Litigation

In March, 1955, the Vermont Structural Slate Company petitioned for a declaratory judgment in the Northern District of New York against Tatko Brothers Slate Co., Inc., Petitioner here, praying that the patent here in suit be declared invalid. Vermont Structural moved for summary judgment declaring the patent invalid for failure to disclose more than an "obvious" step forward in a crowded art. Judge Foley granted the motion and held the patent invalid for lack of invention,* saying:

> "As the plaintiff urges, the most the inventor seems to have here is a 'good idea', a workmanlike

* *Vermont Structural Slate Co., Inc.* v. *Tatko Brothers Slate Co., Inc.*, 134 F. Supp. 4, 107 U. S. P. Q. 86 (N. D. N. Y. 1955).

rearrangement of old elements that enhanced utility without invention beyond the prior art." (134 F. Supp. at p. 6)

In affirming Judge Foley's decision (233 F. 2d 9), the Court of Appeals for the Second Circuit had this to say about the alleged invention of the patent here in suit:

"Nor did it require expert testimony to make it plain that the differences between the prior art and the patent claims were *obvious* to persons having ordinary skill in the trade at the time the alleged invention was made.

* * * * *

"If the question of patentable invention were a 'close one', the facts here thus taken as true might tip 'the scales of judgment' in defendant's favor; but where 'invention is plainly lacking', such a fact 'cannot fill the void'. *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560, 567. We agree with the judge that here the question of invention was not at all close. The patent disclosed no more ingenuity than that of a man skilled in the art." (233 F. 2d at pp. 10-11; emphasis added)

On July 6, 1956, Tatko Brothers filed an infringement suit in the District of Maine against L. C. Andrew, a flagstone customer of Vermont Structural. Because of the small amount involved, Andrew voluntarily defaulted *prior to trial*, and an *ex parte* default judgment for $378.76 was entered by the District Court in October, 1958.

The complaint in the present case against Respondent, Matthew Hannon, a small independent Vermont slate broker, was filed in the District of Vermont on May 13, 1955. In September, 1956, after the Court

of Appeals for the Second Circuit had affirmed Judge Foley's decision, the Vermont District Court denied Hannon's motion for summary judgment, and after a trial, held the patent valid and infringed, basing its holding of validity upon a conclusion that the patent had filled a long-felt need. The Court of Appeals for the Second Circuit reversed this holding, *supra*, p. 1, concluding that the evidentiary facts found by the Vermont District Court did not support that Court's conclusion that a long-felt need had existed. In holding that this conclusion was reviewable on appeal, the Court stated:

> "Accordingly, we turn at once to consider Judge Gibson's holding that the Tatko patent is valid. In this task, the scope of review is clearly defined by the decided cases: primary, or evidentiary, findings of fact may not be disturbed unless clearly erroneous; but the inferences and conclusions, based upon the primary facts, upon which depends the ultimate findings of patentability, as well as the standard of invention applied below, are questions of law fully reviewable in this court. Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. 340 U. S. 147, 87 USPQ 303; Blish, Mize and Silliman Hardware Co. v. Time Saver Tools, Inc., 10 Cir., 236 F. 2d 913, 111 USPQ 6, cert. denied 352 U. S. 1004, 112 USPQ 494. We scrutinize the conclusion of patentability in this case with especial care, since four judges* of this court heretofore, albeit acting upon a somewhat different record of fact, have agreed that the alleged invention is obvious and unpatentable."
> F. 2d , 122 U. S. P. Q. at 586.

* Petitioner at page 8 erroneously asserts that three judges have held this patent valid. The fact is that after *inter partes* consideration, *six* judges (Judges Foley, Frank, Medina, Waterman, Clark, and Hincks) held the patent invalid, and only two (Judges Madden and Gibson) believed it valid.

PETITIONER'S REASONS FOR SEEKING CERTIORARI ARE UNFOUNDED

Petitioner asserts five reasons in support of its request for certiorari, but none of these reasons justifies review by this Court. Taking the Petitioner's reasons in order:

1. This case presents no question of interpretation of the Patent Act of 1952 requiring this Court's consideration, since the Tatko patent is invalid under any conceivable standard of invention.

In the *Vermont Structural* case, *supra*, p. 3, the Court of Appeals for the Second Circuit said:

> "Plaintiff argues that the recent amendment to the patent statute, 35 U. S. C. Section 103, lowered the standard of invention, citing Lyon v. Bausch & Lomb Optical Co., 224 F. 2d 530, 535-536, 106 USPQ 1, 6-7 (C. A. 2). *Even so, the plaintiff's patent, we think, is clearly sub-standard.*" (233 F. 2d at p. 11; emphasis added)

The same Court decided below that the District Court's conclusion as to long-felt need was not supported by the evidence before it. The Court of Appeals held that such conclusion was the sole basis for the District Court's holding of patentability, and that this conclusion was an ultimate finding, reviewable on appeal (*supra*, page 4). This is well-settled law, as stated, for example, in *Noble* v. *C. S. Johnson Co.*, 241 F. 2d 469, 475, 112 U. S. P. Q. 350, 354-355 (7th Cir. 1957):

> "On a trial of a patent case without a jury, the district court has the initial duty of determining the evidentiary facts . . .

> "The next step is a finding by the district court of the ultimate facts, such as invention and anticipation . . . it has been held that the court, in making such finding, is required to apply the correct criteria of law to the evidentiary facts, and whether it has done so is reviewable on appeal as a matter of law . . .
>
> "When the district court has thus found the ultimate facts, it is then its duty to decide, as a matter of law, the overall question of validity which, of course, is likewise subject to review."

See also:

Glitsch & Sons v. *Wyatt*, 224 F. 2d 331, 335, 106 U. S. P. Q. 162, 165 (5th Cir. 1955)

Hobbs v. *Wisconsin Power & Light Co.*, 250 F. 2d 100, 103, 115 U. S. P. Q. 371, 373 (7th Cir. 1957), cert. denied, 356 U. S. 932 (1958)

National Slug Rejectors, Inc. v. *A. B. T. Mfg. Co.*, 164 F. 2d 333, 336, 75 U. S. P. Q. 151, 154 (7th Cir. 1947), cert. denied, 333 U. S. 832 (1948)

Blish, Mize and Silliman Hardware Co. v. *Time Saver Tools, Inc.*, 236 F. 2d 913, 916, 111 U. S. P. Q. 6, 9 (10th Cir. 1956), cert. denied, 352 U. S. 1004 (1957)

Petitioner's attempt to convert a plain run-of-the-mill patent case into an "important matter of national consequence", particularly on the ground that "the last decisions of this Court" on patentability are "a source of doctrinal confusion" is rather farcical and inappropriate.

2. The default judgment in the District Court of Maine was not a "decision" in conflict with the decision of the Court below.

Andrew accepted an adverse default judgment in Maine because of the small damages involved, $378.75. Judge Gignoux's order in the *Andrew* case made the *ex parte* nature of its disposal abundantly clear:

> "Upon the Amended Complaint filed in open court on August 11, 1958; upon defendant's subsequent default that day in open court; upon the waiver of notice of application for default judgment, which waiver has been duly filed; and upon consideration of testimony, depositions and demonstrations made to this Court, ex parte, the Court finds as follows: . . ." (Petition, Appendix B)

Such a non-adversary default judgment does not create a "real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeal", as required by this Court in *Layne & Bowler Corp.* v. *Western Well Works, Inc.*, 261 U. S. 387, 393 (1923). The District Court's *ex parte* order cannot possibly be the law of the First Circuit, whose Court of Appeals has never considered any aspect of this litigation.

3. The facts do not support Petitioner's contention that a conflict between the circuits is unlikely.

A substantial segment of the slate-quarrying industry is located in the Third Judicial Circuit, and one infringement suit based on this patent has already been filed and settled therein. *Vatko Brothers Slate Co., Inc.* v. *Bergen Blaustone Co., Inc.*, D. C. N. J. Newark Doc. 490-55, settled and dismissed March 23, 1956, 706 Pat. Off. Official Gazette 5 (May 1, 1956).

As a matter of fact, in the present case the Petitioner took the depositions of five slate quarrymen (R. Vol. I, pp. 88-99), all doing business in Pennsylvania and using pallets in the shipment of slate.

Indeed, slate and flagstone are shipped and sold throughout the United States, and an infringement suit based on *use* of the pallets in question could be filed in any one of the eleven judicial circuits.

4. The decision of the Court below as to "obviousness" is not in conflict with the decisions of any other circuits.

Section 103 of the Patent Act of 1952 is not mentioned in the decision below. The application of the standard of invention involving "obviousness" depends upon the particular facts of each individual case, and the Court of Appeals' holding of obviousness here is not "in conflict" with holdings of *non*obviousness in *other* cases involving *other* facts.

In *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530 (2nd Cir. 1955), cert. denied, 350 U. S. 911 (1955), Judge Learned Hand defined the effect of § 103 as "restoring the original gloss, substantially in *ipsissimis verbis*; which has never been overruled; but on the contrary for seventy or eighty years has been regarded as authoritative". This decision declares the law of the Second Circuit, and is cited with approval in the cases relied on by Petitioner in its point 4: *L-O-F Glass Fibers Co.* v. *Watson*, 228 F. 2d 40 (D. C. Cir. 1955); *Palmer* v. *Ludens, Inc.*, 236 F. 2d 496 (3rd Cir. 1956); and *Otto* v. *Koppers Co.*, 246 F. 2d 789 (4th Cir. 1957). After holding that the Tatko pallet did

not fill a long-felt need, the Court below distinguished the present case on its facts from *Lyon* v. *Bausch & Lomb*, supra. Petitioner's three cases are distinguishable for the same reason.

The different result in the present case arising from different facts does not create a question of law worthy of this Court's attention.

3. The decision of the Court of Appeals that the evidence presented in the District Court failed to establish long-felt want is not in conflict with decisions of this Court.

The Court of Appeals realized that a showing of long-felt want, attempts by others to solve the problem without success, etc., were factors to be considered, for it said:

> "We assume that in this case no prior art pallet was shown with terminal slots which could be used for the insertion, by hand, of side walls. The central problem of the case may thus be framed: Did it involve patentable invention to substitute in a pallet for Lilienfeld's hand operated hinged side arms Tatko's slots for the manual insertion of slate side walls as a means to hold the load in place?
>
> "The affirmative answer to this question made below was based in turn upon another conclusion, viz., that the addition of Tatko's slots to the conventional two-tier pallet 'called for more than was obvious to a person having ordinary skill in the slate industry.' And the latter conclusion was apparently based on a finding that 'for a considerable length of time people skilled in the trade worked to devise an effective pallet for the purpose of easily and safely handling flagstone and slate, but this innovation [i. e., the *slotted* pallet]

> escaped them.' But this finding, we think, was an insufficient basis for a conclusion as to what was *obvious* in the industry." (122 U. S. P. Q. at p. 586)

The Court of Appeals did not "brush aside the findings of the District Court", but held that on the *facts* found by the District Court, long-felt want was not present in this case, *supra* p. 2.

After analyzing Tatko's simple advance over the prior art, the Court correctly stated:

> "To make such a simple choice and to embody it in the pallet, called for no skill beyond that of an ordinary mechanic in the slate-pallet art. We think it altogether plain that the patent in suit was lacking in patentable invention." (122 U. S. P. Q. at p. 587)

Conclusion

Basically, Petitioner argues that certiorari should be granted in the present case because some people feel that there is "a new mood", a "lower standard of invention" under the Patent Act of 1952 than under the prior law, and that there is "confusion" as to the present standard of invention. This "new mood" theory is a pure figment of Petitioner's hopeful imagination. The law is as it has been—a trivial advance cannot be patentable. Here, as the Court of Appeals stated in the *Vermont Structural* decision, *supra* p. 3, the patent is "clearly sub-standard."

Furthermore, such questions were not raised or decided in this case, for the Court of Appeals' conclusion of non-patentability was primarily based on the significant fact that "the want (for slate pallets) was not felt until the prevalence of fork-lift trucks *and*

then was promptly filled." (122 U. S. P. Q. at page 587, emphasis ours)

There is absolutely nothing in the record before this Court to justify a large expenditure of its time to review the merits of what is and always has been an ordinary patent dispute. Accordingly, the petition for certiorari should be denied.

Respectfully submitted,

JOHN C. BLAIR
One Atlantic Street
Stamford, Connecticut
Attorney for Respondent

Of Counsel:

BLAIR SPENCER & BUCKLES
ROBERT H. WARE
ROBERT A. CESARI
F. EUGENE DAVIS IV
One Atlantic Street
Stamford, Connecticut

J. MALCOLM WILLIAMS
Poultney, Vermont

November 19, 1959

Affidavit of Service

STATE OF NEW YORK)
COUNTY OF NEW YORK) ss:

WILLIAM J. MEEHAN, being duly sworn, deposes as follows:

This brief was served by mailing three copies thereof today, first class postage prepaid, addressed to J. Preston Swecker, Esq., 923 Washington Building, Washington, D. C., Attorney for Petitioner, in compliance with Rule 33(1) of this Court.

WILLIAM J. MEEHAN

Subscribed and sworn to before me this 19th day of November, 1959.

MARY JANE MARCHESE
Notary Public

[NOTARIAL SEAL]

MARY JANE MARCHESE
Notary Public, State of New York
Qualified in Kings County
No. 24-7708650
Certs. filed with N. Y. Co. Clk.
Commission Expires March 30, 1960

ILE COPY

Office Supreme Court, U.S.
FILED
DEC 3 1959
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 491

TATKO BROTHERS SLATE CO., INC., *Petitioner*

v.

MATTHEW HANNON, *Respondent*

REPLY OF PETITIONER TO RESPONDENT'S BRIEF

J. PRESTON SWECKER
923 Washington Building
Washington, D. C.
Attorney for Petitioner

Of Counsel:

WILLIAM C. SENNETT
Bennington, Vermont

MAXWELL E. SPARROW
665 Fifth Avenue
New York, New York

WILLIAM L. MATHIS
923 Washington Building
Washington 5, D. C.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

INDEX

	Page
The Judgment of the Court Below Denied Application of the Doctrine of Lyon v. Bausch & Lomb	1
Conflict of Decisions of Different Circuits Cannot Be Reconciled by Facts Involved	2
Respondent Tacitly Concedes a Conflict Between the Decision Below and This Court's Decision in Goodyear v. Ray-O-Vac	5
Conclusion	5

INDEX OF CASES

A & P Tea Co. v. Supermarket Corp., 340 U.S. 147	3
Cuno Corp v. Automatic Devices Corp., 314 U.S. 84	3
Expanded Metal Co. v. Bradford, 214 U.S. 366, 381	3, 5
Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Co., 321 U.S. 275	3, 5
L-O-F Glass Fibers Co. v. Watson, 228 F. (2d) 40	3
Lyon v. Bausch & Lomb Optical Co., (C.A. 2), 224 F. (2d) 530	1, 2, 3
Otto v. Koppers Co. (C.A. 4), 246 F. (2d) 789	4
R. M. Palmer Co. v. Ludens, Inc. (C.A. 3), 236 F. (2d) 496, 111 USPQ 1, 3	4

IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 491

TATKO BROTHERS SLATE CO., INC., *Petitioner*

v.

MATTHEW HANNON, *Respondent*

REPLY OF PETITIONER TO RESPONDENT'S BRIEF

The Judgment of the Court Below Denied Application of the Doctrine of Lyon v. Bausch & Lomb

Verbally, the Court below paid tribute to the doctrine enunciated in *Lyon* v. *Bausch & Lomb Optical Co.* (C.A. 2), 224 F. (2d) 530, cert. denied 350 U.S. 911. By its ruling, the law as declared with respect to Section 103 of the Patent Act of 1952 by Judge Learned Hand, was distinguished in the present case only on the meager differences in the facts involved. The cases cannot be distinguished on that basis alone without doing violence to the principle of law announced in Lyon v. Bausch & Lomb, or without disregarding

the findings of fact of the District Court as to the particular facts in this case, contrary to the expressed mandate of Rule 52(a) FRCP.

The Respondent's Brief admits (page 8) that the Court of Appeals disregarded Section 103 of the 1952 Patent Act. It should not have been ignored. The 1952 Patent Act was the very basis of the decision in Lyon v. Bausch & Lomb, and this section was the heart of Judge Madden's dissenting opinion in this case. The latter specifically relied upon the terms of Section 103 of the 1952 Act. Since the new Act was so disregarded by the majority opinion below, and since it was the very principle of Judge Learned Hand's opinion in Lyon v. Bausch & Lomb, this gives rise to an admitted conflict with other applicable decisions interpreting Section 103 of the 1952 Act, and its applicability to this case.

Conflict of Decisions of Different Circuits Cannot be Reconciled by Facts Involved

It is rare indeed when two patent cases arise on precisely the same facts. The principles of law involved; and especially the interpretation of Section 103 of the 1952 Act, do not depend upon the facts which distinguish nearly every case, one from another.

Here the District Court predicated its findings of fact on the evidence presented to that Court, and from that evidence, presented in the light of Section 103 of the 1952 Act, as interpreted in Lyon v. Bausch & Lomb, concluded that the patent in suit is valid. The Court of Appeals, in the majority opinion, admittedly without consideration of Section 103 of the 1952 Act, concluded, from its *de novo* review of the facts contrary to the provisions of Rule 52(a) FRCP, that the

patent in suit is invalid. It is on the basis of these same findings of fact that the Court of Appeals asserted a distinction from the decision in Lyon v. Bausch & Lomb.

This holding by the Court of Appeals leaves the case in direct conflict with decisions in other circuits, and with the decision of this Court in *Goodyear Tire & Rubber Co., Inc.* v. *Ray-O-Vac Co.*, 321 U.S. 275 (although the latter was decided prior to the 1952 Act).

The rule of law which is applicable to this situation is that *where there has long been a want in the trade for the particular invention, and others have sought to solve the problem without success, and when the patentee solved it, the trade readily adopted that solution, these circumstances should, at least in a close case, tip the scales in favor of patentability.* These are criteria for patentability within the definition of Section 103 of the 1952 Act. The decision of the Court below failed to give effect to this new "mood", as expressed by Judge Madden in his dissenting opinion.

This principle of law was announced by this Court at least as early as 1909 in *Expanded Metal Co.* v. *Bradford*, 214 U.S. 366, 381. In following the latter case, as distinguished from such more recent decisions as *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, and *A & P Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147, the Court of Appeals for the District of Columbia, in *L-O-F Glass Fibers Co.* v. *Watson*, 228 F. (2d) 40, stated in footnote 14:

> "We may safely assume that the Patent Act of 1952, 35 U.S.C.A. §103, was intended to restore 'the law to what it was when the court announced

the definition of invention.' See discussion by Judge Learned Hand in Lyon v. Bausch & Lomb Optical Co."

To the same effect is the construction of this section in *R. M. Palmer Co.* v. *Ludens, Inc.* (C.A. 3), 236 F. (2d) 496, 111 USPQ 1, 3:

> "In the field of judicial testing of the validity of patents, it is a common observation that the law is settled, the difficulty existing in its application. Here, the plaintiff has introduced an argument as to the effect of the Patent Act of 1952, 35 U.S.C., 1952 ed. Section 1, et seq. The argument presupposes that the courts, as a result of the 'flash of genius' expression in Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84, 91, 51 USPQ 272, 275 (1941), have applied a higher, more rigid standard for determining validity, and that the recent Act, 35 U.S.C., 1952 ed. Section 103, constitutes a *congressional change of direction* to assertedly more lenient criteria." (Italics added)

The "congressional change of direction" there referred to is the same as the new "mood" as mentioned by Judge Madden, imported by the new Statute.

To the same effect, is the decision in *Otto* v. *Koppers Co.* (C.A. 4), 246 F. (2d) 789. In view of this diversity of interpretation of the Patent Statute, both within and without the Second Circuit, it is important that this Court lay at rest these differences as to its interpretation, and determine whether the Court below properly applied the rules of law prescribed by the new Statute.

Respondent Tacitly Concedes a Conflict Between the Decision Below and This Court's Decision in Goodyear v. Ray-O-Vac

No mention is made of the latter decision in the Respondent's Brief. In Section 5 thereof, there are only quotations from the majority opinion of the Court of Appeals, but those cannot cover up the direct conflict between the decision below and this Court's decision in the Goodyear case.

Admittedly, the Goodyear case, like *Expanded Metal Co.* v. *Bradford*, *supra*, was decided prior to the enactment of the 1952 Patent Act, but the cases referred to above have declared, in interpreting Section 103, that it was intended by Congress to restore the Patent Law to what it was declared to be by this Court in the realm of time of the Bradford and Goodyear cases. If that be the proper interpretation of the new law, then the rule in the Goodyear case ought to be taken into account in deciding the question of patentability here involved.

Conclusion

The uncertainty that has grown up with respect to the effect of the 1952 Patent Act on the determination of patentability of inventions, and the divergence of interpretation of Section 103 thereof, and the applicability thereof in determining questions of patentability, present a problem in this branch of the law that deserves determination by this Court.

Petitioner stands upon its petition and all of the reasons therein relied upon for the allowance of the writ.

Respectfully submitted,

J. Preston Swecker
923 Washington Building
Washington, D. C.
Attorney for Petitioner

Washington, D. C.
December 2, 1959

Of Counsel:

William C. Sennett
Bennington, Vermont

Maxwell E. Sparrow
665 Fifth Avenue
New York, New York

William L. Mathis
923 Washington Building
Washington 5, D. C.